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PATENT

Remarks

Claims 1 to 9 are pending in the above-identified patent application.

Discussion of the Restriction Requirement Pursuant to 35 U.S.C. § 121

The Action requires Applicant to select one of the following allegedly patentably distinct inventions for examination:

Group I: Claims 1-9, drawn to compound of formula I wherein in formula II, both X1 and X2 are nitrogen, namely pyridazine, composition and method of use, classified in class 544, subclasses 224, 239, class 514, subclass 247.

Group II: Claims 1-9, drawn to compound of formula I wherein in formula II, either X1 or X2 is nitrogen the other carbon, namely isomeric pyridine, classified in class 546, subclasses 297, class 514, subclass 313.

(Action at 2). The Action alleges that the “[i]nventions of group I and II are independent and distinct from each other because they are directed to dissimilar compounds with varying cores such [as] pyridazine vs isomeric pyridine cores” (Id.). No “species” election requirement from within the elected group was issued.

Applicants respectfully traverse the restriction requirement for the following reasons.

The Election Requirement is Improper Based on the MPEP §803.02 And Relevant Case Law

Applicants submit respectfully that the restriction requirement is improper because it divides Applicants’ Markush claim in contravention to the requirements of MPEP §803.02 and the case law.

A. MPEP §803.02 Considerations

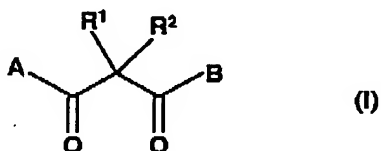
MPEP §803.02 provides that there is no basis for a restriction of a Markush claimed invention where two factors are met, i.e.,

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... compounds included within a Markush group (1) share a common utility and (2) share a substantial structural feature ...

Applicants' claimed invention meets the aforesaid factors. That is: (A) the compounds of the claimed invention all share a substantial structural feature, *i.e.*, the compound of the formula I



; and

B) their compounds share a common utility, *i.e.*, being useful for therapy and prophylaxis of thromboembolic diseases and restenoses.

Moreover, it is well-established that the Office Action must provide reasons and/or examples to support conclusions when issuing a restriction requirement. MPEP § 803. The Office Action, however, has completely ignored this requirement. Indeed, the Office Action has provided *no* evidence or technical reasoning to support its apparent conclusion that the compounds of Groups I and II do *not* share a common utility and do *not* share a substantial structural feature. Accordingly, the restriction requirement is improper on its face for failing to comply with the requirements set forth in the MPEP.

Case Law Considerations

As detailed below, well-settled case law such as, for example, *In re Harnisch*, 206 U.S.P.Q. 300 (CCPA 1980) and *Ex parte Dahlen and Zwilgmeyer*, 42 U.S.P.Q. 208 (Bd. App., 1938), supports Applicants' position that the present restriction requirement is improper because, as stated above, the Office Action has provided *no* evidence or technical reasoning to support its apparent conclusion

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that the compounds of Groups I and II do *not* share a common utility and do *not* share a substantial structural feature.

In re Harnisch, 206 U.S.P.O. 300 (CCPA 1980)

In *In re Harnisch*, 206 U.S.P.Q. 300 (CCPA 1980), the court found that an invention claimed in a Markush type claim was proper for compounds having a common utility and "*a single structural similarity*" (emphasis added). In particular, in agreeing with its earlier decisions, the court stated that a Markush group was proper where there is a

grouping of compounds having the *same nuclei but side chains wherein there was a wide variation* ... and had *a community of properties justifying their grouping* ... was not repugnant to principles of scientific classification.

In re Harnisch, 206 U.S.P.Q. at 305 (emphasis added). The Court held that, when such criteria exist, there is unity of invention within the claimed Markush group. *Id.*

Applicants' claimed invention meets the standard of *In re Harnisch* as it indeed has the requisite single structural similarity (*i.e.*, the substantial structural feature from MPEP §803.02) and shares a common utility, as noted above. Therefore, there is no propriety for the present restriction requirement.

Accordingly, reconsideration and withdrawal of the species election/restriction requirement is requested respectfully.

Election

Although Applicant submits respectfully that the imposed restriction is improper, in an attempt to advance the prosecution of this application to allowance, Applicants elect **Group II**. Further, Applicants reserve the right to pursue any compounds that remain after prosecution of the instant patent application in a future divisional patent application.

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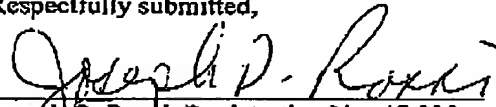
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Conclusion

Applicants believe that the foregoing constitutes a complete and full response to the Office Action of record. Applicants respectfully submit that this application is now in condition for allowance. Accordingly, an indication of allowability and an early Notice of Allowance are respectfully requested.

The Commissioner is hereby authorized to charge the fee required and any additional fees that may be needed to Deposit Account No. 18-1982 in the name of Aventis Pharmaceuticals Inc.

Respectfully submitted,


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